

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/563,758 Confirmation No. 3144
Applicant : Guy Servant, et al.
PCT Application No. : PCT/US2004/021853
Int. Filing Date : 09 July 2004
Title : IMPROVED ELECTROPHYSIOLOGICAL ASSAYS USING
OOCYTES THAT EXPRESS HUMAN ENaC AND THE USE OF
PHENAMIL TO IMPROVE THE EFFECT OF ENaC
ENHANCERS IN ASSAYS USING MEMBRANE POTENTIAL
REPORTING DYES
TC/Art Unit : 1649
PCT Legal Examiner: : Bryan Lin

Docket No. : 67824.431530
Customer No. : **21967**

Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PETITION
DECISION REGARDING RENEWED PETITION

Sir:

Applicants respectfully request reconsideration of the Petition Decision mailed on June 25, 2008. In this decision the PCT Legal Examiner indicated that the Petition Under 37 CFR 1.497(d) and under 1.137(b) was incomplete based on the apparent failure of Applicants to satisfy MPEP 1893.01(e) (C) which requires the written consent of the assignee if an assignment has been executed by any of the original named inventors. The Petition notes that a statement under 37 3.73(b) was filed on April 26, 2006 but an Assignment did not accompany this submission as referenced in the 3.73(b) Statement.

In response thereto Applicants respectfully note that no Assignment was submitted and also note that this 3.73(b) Statement was referring to an Assignment document submitted on May 2, 2005 in US Serial No. 10/887,233 which utility application was filed on even date (July 9,

2004) as the PCT application PCT/US2004/021853 and which utility application claims priority to the same provisional application, US Serial No. 60/485,745, filed on July 10, 2003, to which the PCT on which this national phase application claims priority. Applicants further note that the specification, figures and claims of the as-filed national phase application, US Serial No. 10/563,758 are identical to those in US Serial No. 10/887,233 and that this application was filed with a Petition as herein adding Bryan Moyer as an inventor and that the Petition was granted.

In response to the failure to submit the referenced Assignment, Applicants submit herewith a copy of the Assignment and Statement by the Assignee submitted in US Serial No. 10/887,233 (Appendix A) and request that these documents be found acceptable to satisfy the omitted item set forth in Section III of the Petition decision. Applicants request this assignment be accepted since this Assignment was signed by all of the inventors for an application having the same effective filing date, containing the identical specification, priority claim and which relates and claims the identical invention and subject matter. With respect thereto, this Assignment states that it covers all continuations, divisionals, extensions and the inventors acknowledge that the assignment covers "all right, title and interest for the United States, territories and possessions for the invention set forth in US Serial No. 10/887,233". This statement and Assignment of rights to Senomyx by all of the inventors should be acceptable herein since the identical invention (based on identical inventors, specification, figures, claims and effective filing date) is being claimed herein. This finding is further consistent with the Statement in US Serial No. 10/887,233 wherein the Assignee Senomyx Inc. indicated that this Assignment covered "the invention covering the subject matter of US Serial No. 10/887,233" (since it is based on the identical subject matter as in the subject application).

Alternatively, if the Assignment document submitted in 10/887,233 is found unacceptable to the subject application Applicants respectfully request that the requirement for the Assignment be waived for this application being deemed to be complete as the written consent of the Assignee according to MPEP 1893.01(e) is only required if an assignment document has been executed by the original inventors. Herein (if the assignment in 10/887,233 is deemed unacceptable) such an assignment was not executed by the original named inventors.

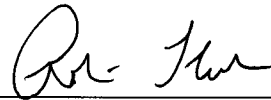
Based on the foregoing, Applicants respectfully submit that the Petition Decision should be granted and that this application should be transferred to the Technology Group for examination on the merits. This application is being submitted with a one-month extension. In the event that any further fees are deemed necessary, the Commissioner is authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: October 27, 2008

By:



Robin L. Teskin

Registration No. 35,030

Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

RLT:dk

APPENDIX A

**This Page is Inserted by IFW Indexing and Scanning
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BEST AVAILABLE IMAGES

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NO. 6687 P. 11

Attorney Docket No.:100337.54315US

U.S. Rights--Sole or Joint

ASSIGNMENT

For good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, each undersigned inventor has sold and assigned, and by these presents hereby sells and assigns, unto:

SENOMYX, INC.
11099 N. TORREY PINES ROAD
LA JOLLA, CA 92037

(hereinafter ASSIGNEE) all right, title and interest for the United States, its territories and possessions in and to his invention relating to:

Improved Electrophysiological Assays Using Oocytes that Express Human ENaC and the use of Phenamil to Improve the Effect of ENaC Enhancers in Assays Using Membrane Potential Reporting Dyes

as set forth in his United States Patent Application (check one):

- ☐ executed concurrently herewith,
☐ executed on _____,
☒ Serial No. 10/887,233, filed July 9, 2004,
PCT International Application, No.: _____, filed _____,

in and to said United States Patent Application including any and all divisions or continuations thereof and in and to any and all Letters Patent of the United States which may issue on any such application or for said invention, including any and all reissues or extensions thereof, to be held and enjoyed by said ASSIGNEE, its successors, legal representatives and assigns to the full end of the term or terms for which any and all such Letters patent may be granted as fully and entirely as would have been held and enjoyed by the undersigned had this Assignment not been made;

Each of the undersigned hereby authorizes and requests the Commissioner of Patents and Trademarks to issue any and all such Letters patent to said ASSIGNEE, its successors or assigns in accordance herewith;

Each of the undersigned warrants and covenants that he has the full and unencumbered right to sell and assign the interests herein sold and assigned and that he has not executed and will not execute any document or instrument in conflict herewith;

Each of the undersigned further covenants and agrees he will communicate to said ASSIGNEE, its successors, legal representatives or assigns all information known to him relating to said invention or patent application and that he will execute and deliver any papers, make all rightful oaths, testify in any legal proceedings and perform all other lawful acts deemed necessary or desirable by said ASSIGNEE, its successors, legal representatives or assigns to perfect title to said invention, to said application including divisions and continuations thereof and to any and all Letters Patent which may be granted therefor or thereon, including reissues or extensions, in said ASSIGNEE, its successors, or assigns or to assist said ASSIGNEE, its successors, legal

representatives or assigns in obtaining, reissuing or enforcing Letters Patent of the United States for said invention;

Each of the undersigned hereby grants the firm of CROWELL & MORING, L.L.P., or any partner thereof, the power to insert in this Assignment any further identification which may be necessary or desirable to comply with the rules of the U.S. Patent and Trademark Office for recordation of this Assignment.

Sherry Dellins
(Signature of witness (optional))

Guy SERVANT

Guy S
(Signature of 1st inventor)03-07-05
(Date)

Sherry Dellins
(Signature of witness (optional))

Hong CHANG

Hong Chang
(Signature of 2nd inventor)03-28-05
(Date)

Sherry Dellins
(Signature of witness (optional))

Cyril REDGROW

Cyril C. Redgrow
(Signature of 3rd inventor)03-29-05
(Date)

Sherry Dellins
(Signature of witness (optional))

Sumita RAY

Sumita Ray
(Signature of 4th inventor)3/9/05
(Date)

Sherry Dellins
(Signature of witness (optional))

Imran CLARK

Imran Clark
(Signature of 5th inventor)
(Date)

Sherry Dellins
(Signature of witness (optional))

Bryan Moyer

Bryan Moyer
(Signature of 5th inventor)3-7-05
(Date)

representatives or assigns in obtaining, reissuing or enforcing Letters Patent of the United States for said invention;

Each of the undersigned hereby grants the firm of **CROWELL & MORING, L.L.P.**, or any partner thereof, the power to insert in this Assignment any further identification which may be necessary or desirable to comply with the rules of the U.S. Patent and Trademark Office for recordation of this Assignment.

Guy SERVANT

(Signature of witness (optional))

(Signature of 1st inventor) (Date)

Hong CHANG

(Signature of witness (optional))

(Signature of 2nd inventor) (Date)

Cyril REDGROW

(Signature of witness (optional))

(Signature of 3rd inventor) (Date)

Sumita RAY

(Signature of witness (optional))

(Signature of 4th inventor) (Date)

Lama Thomas 3/10/05

(Signature of witness (optional))

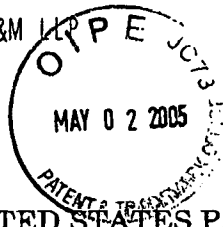
Imran CLARK
Imran Clark 3/10/05

(Signature of 5th inventor) (Date)

Bryan Moyer

(Signature of witness (optional))

(Signature of 5th inventor) (Date)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/887,233 : Confirmation No. : 2052
First Named Inventor : Guy SERVANT
Filed : July 9, 2004
TC/A.U. : 1646
Examiner : Unassigned
Docket No. : 100337.54315US
Customer No. : 23911
Title : Electrophysiological Assays Using Oocytes that Express
Human ENaC and the Use Phenamil to Improve the Effect
of ENaC Enhancers in Assays Using Membrane Potential
Reporting Dyes


STATEMENT PURSUANT TO 37 C.F.R. 1.48(a)(5)
FROM ASSIGNEE SENOMYX, INC.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

By virtue of an Assignment executed by Guy Servant, Hong Chang, Cyril Redcrow, Sumita Ray, Imran Clark and Bryan Moyer, (copy attached), Senomyx, Inc. is the assignee of all right, title and interest for the United States, its territories and possessions, in and to the invention forming the subject matter of the U.S. Patent identified above. Senomyx, Inc. hereby agrees to the change of inventorship by which Guy Servant, Hong Chang, Cyril Redcrow, Sumita Ray, Imran Clark and Bryan Moyer as named co-inventors.

Senomyx, Inc.

By: 
Signature
Name: Harry J. Leonhardt, Esq.
(Please Print)

Date: March 18, 2005
V.P., General Counsel
Title: Corporate Secretary



[Handwritten signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/887,233 Confirmation No. : 2052
First Named Inventor : Guy SERVANT
Filed : July 9, 2004
TC/A.U. : 1646
Examiner : Unassigned
Docket No. : 100337.54315US
Customer No. : 23911
Title : Electrophysiological Assays Using Oocytes that Express Human ENaC and the Use Phenamil to Improve the Effect of ENaC Enhancers in Assays Using Membrane Potential Reporting Dyes

Petition to Correct Inventorship Under 37 CFR § 1.48(a)

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is requested that the inventorship of the U.S. Patent application identified above be corrected to include the inventor Bryan Moyer. Attached are the following:

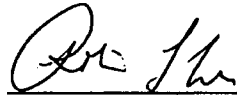
1. Statement Pursuant to 37 C.F.R. 1.48(a)(2) by Bryan Moyer;
2. Declaration Power of Attorney;
3. Assignment;
4. Statement Pursuant to 37 C.F.R. 1.48(a)(5) from Assignee Senomyx, Inc.; and
5. Check in the amount of \$130.00 to cover the Petition Fee.

If there are any questions regarding this Petition or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #100337.54315US).

May 2, 2005

Respectfully submitted,



Robin L. Teskin
Registration No. 35,030

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
RLT:ch



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/887,233 Confirmation No. : 2052
First Named Inventor : Guy SERVANT
Filed : July 9, 2004
TC/A.U. : 1646
Examiner : Unassigned
Docket No. : 100337.54315US
Customer No. : 23911
Title : Electrophysiological Assays Using Oocytes that Express Human ENaC and the Use Phenamil to Improve the Effect of ENaC Enhancers in Assays Using Membrane Potential Reporting Dyes

STATEMENT PURSUANT TO 37 C.F.R. §1.48(a)(2) BY BRYAN MOYER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

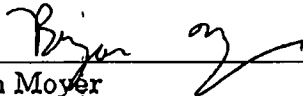
As the individual whose signature appears below, I hereby declare that:

1. I am a co-inventor of the subject matter of the U.S. Patent identified above.
2. I was erroneously omitted as a named co-inventor of the subject matter of the U.S. Patent identified above.
3. The inventorship error in the U.S. Patent identified above occurred without any deceptive intention on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and

Serial No. 10/887,233

that such willful false statements may jeopardize the validity of the application
or any patent issuing thereon.



Bryan Moyer
12521 Spindletop Road
San Diego, CA 92129

Attorney Docket No. 100337.54315US

DECLARATION AND POWER OF ATTORNEY
(For Use with Application Data Sheet)

As the below named inventor(s), I/we declare that:

This declaration is directed to:

____ The attached application, or
____ was filed as PCT international application Number _____ on _____
X Application No. 10/887.233, filed on July 9, 2004 as amended on _____
_____ (if applicable);

I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought.

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including material information which became available between the filing date of the prior application and the National or PCT International filing date of the continuation-in-part application, if applicable;

I/we hereby appoint the practitioners at CROWELL & MORING L.L.P., whose Customer Number is:

23911

as my/our attorneys to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith; and

All statements made herein of my/our own knowledge are true; all statements made herein on information and belief are believed to be true, and further these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME(S) of INVENTOR(S)

Signature: Guy SERVANT
Inventor one: Guy SERVANT
Citizen of: Canada

Date: 03-07-05

Signature: Hong CHANG
Inventor two: Hong CHANG
Citizen of: United States of America

Date: 03-28-05

Signature: Cyril C. REDCROW
Inventor three: Cyril REDCROW
Citizen of: Canada

Date: 03-29-05

X Additional Inventors on Attached sheet if checked

Page 2

Signature: Sumita Ray
Inventor four: Sumita RAY
Citizen of: Unites States of America

Date:

3/9/05

Signature: _____
Inventor four: Imran CLARK
Citizen of: Unites States of America

Date: _____

Signature: Bryan MOYER
Inventor four: Bryan MOYER
Citizen of: Unites States of America

Date:

3-7-05

Page 2

Signature: _____
Inventor four: Sumita RAY
Citizen of: Unites States of America

Date: _____

Signature: 
Inventor four: Imran CLARK
Citizen of: Unites States of America

Date: 3/10/05

Signature: _____
Inventor four: Bryan MOYER
Citizen of: Unites States of America

Date: _____